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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/536,827

10/31/2005

Ken Inose

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7590

10/20/2008

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EXAMINER

CHONG, DAVID W

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

10/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/536,827	<b>Applicant(s)</b> INOSE ET AL.	
	<b>Examiner</b> DAVID CHONG	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/27/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/27/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,391,541 to Petersen et al.

3. Regarding claims 1 and 2, Petersen teaches a device for pretreating a specimen comprising a single base (FIG. 1, bottom piece 26), a specimen introducing portion capable of liberating a nucleic acid from the specimen (FIG. 3, inlet port 64); a holding portion for holding the nucleic acid (FIG. 3 sample chamber 65 for holding a fluid); a wash storage (FIG. 3, wash chamber 66); an elute storage (FIG. 7, reagent chamber 67); a discharging portion for discharging liquid (FIG. 3, waste chamber 68); wherein the specimen introducing portion, the holding portion, the wash storage, the elute storage, and the discharging portion are provided together on the single base (cartridge 24 containing all the components on base 28).

4. Regarding claims 3, Petersen teaches a device for pretreating a specimen comprising a single base (FIG. 1, bottom piece 26), a specimen introducing portion capable of liberating a nucleic acid from the specimen (FIG. 3, inlet port 64); a holding portion for holding the nucleic acid (FIG. 3 sample chamber 65 for holding a fluid); a

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discharging portion for discharging a wash (FIG. 3, waste chamber 68 for receiving used wash solution); an extracting portion for extracting the nucleic acid (FIG. 2, reaction vessel 42); grooves provided on the base (various channels, col. 5 lines 46-49), wherein on the base, the holding portion is connected through the grooves to the specimen introducing portion, the discharging portion, and the extracting portion, respectively (FIG. 4 shows on cartridge 24, various channels or grooves connecting the holding portion, specimen introducing portion, discharging portion and extracting portion).

5. Regarding claim 4, Petersen teaches a device for pretreating a specimen comprising a single base (FIG. 1, bottom piece 26), a specimen introducing portion capable of liberating a nucleic acid from the specimen (FIG. 3, inlet port 64); a holding portion for holding the nucleic acid (FIG. 3 sample chamber 65 for holding a fluid); a discharging portion for discharging a wash (FIG. 3, waste chamber 68 for receiving used wash solution); and wherein the specimen introducing portion, the holding portion, the extracting portion, and the discharging portion are provided together on the base (cartridge 24 on base 28). Petersen teaches an air pump (pneumatic pump, col. 6 lines 9-10); connectors connected to the air pump (pressure nozzle, col. 16 line 8); wherein the extracting portion and the discharging portion are connected through the respective connectors to the air pump (col. 15, lines 66-67 to col. 16 line 1), and capable of inhaling air from the connectors so as to control a movement of the liquid on the base (col. 16 lines 11-17).

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,422,249 to Certa et al. and US 6,644,104 to Pourahmadi et al. both teach devices for pretreating samples.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID CHONG whose telephone number is (571)270-3718. The examiner can normally be reached on Monday through Friday, 7:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DC/

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797